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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In re Application Ser. No. 78/295,266 – Shield & Cross Design
Published: May 25, 2004



JOHNSON & JOHNSON, :

Opposer, :

v. :

GENUINE BRANDS LLC, :

Applicant. :

11-22-2004

U.S. Patent & TMO/TM Mail Rcpt Dt. #11

Opposition No. _____

12/02/2004 SWILSON1 00000040 500573 78295266

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300.00 DA

NOTICE OF OPPOSITION

JOHNSON & JOHNSON, a New Jersey corporation, having a principal place of business at One Johnson & Johnson Plaza, New Brunswick, New Jersey 08933-7001 (“Opposer”), believes that it will be damaged by the registration of the mark shown in application Serial No. 78/295,266 – Shield & Cross Design for “perfumery, soaps for personal use, cosmetics for the lips, eyes and face, non-medicated nail treatment preparations, beauty and body care products, namely, skin cleansing and moisturizing lotions and creams, body lotion, body cream, body wash, body shave gel, anti-perspirant, deodorant, hand cream, hand lotion, hair care preparations and hair color”; filed on September 3, 2003 by Genuine Brands LLC, a New York corporation, having an address at 10 West 33rd Street, Suite 728, New York, New York 10001 (“Applicant”); and hereby opposes the same pursuant to §13 of the Trademark Act of 1946 (15 U.S.C. §1063).

As grounds for opposition it is alleged that:

1. The Opposer has adopted and is using the mark Red Cross Design for medical and

surgical plasters; first aid kits, adhesive bandages, topical preparations for medical and

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FILED BY COURIER
November 22, 2004

therapeutic use, medical adhesive tape, gauze, sterile cotton for medical purposes and wound dressings; and cotton for cosmetic use.

2. The Opposer has continuously used the Red Cross Design mark in connection with medical and surgical plasters since as early as 1887.

3. The Opposer has continuously used the Red Cross Design mark in connection with cotton for cosmetic use since as early as 1898.

4. The Opposer has continuously used the Red Cross Design mark in connection with first aid kits, adhesive bandages, topical preparations for medical and therapeutic use, medical adhesive tape, gauze, sterile cotton for medical purposes and wound dressings since as early as 1898.

5. The Opposer has adopted and is using the mark RED CROSS for cotton for personal use and sterile cotton for medical use.

6. The Opposer has continuously used the mark RED CROSS for cotton for personal use and sterile cotton for medical use since as early as 1898.

7. Opposer is the owner of:

- a. Reg. No. 54,308 – Red Cross Design, dated June 26, 1906, for medical and surgical plasters.
- b. Reg. No. 1,870,955 – RED CROSS, dated January 3, 1995, for sterile cotton for personal use and sterile cotton for medical use.
- c. Reg. No. 1,888,143 – Red Cross Design, dated April 11, 1995, for cotton for cosmetic use.
- d. Reg. No. 1,889,576 – Red Cross Design, dated April 18, 1995, for first aid kits, adhesive bandages, topical preparations for medical and therapeutic use, medical adhesive tape, gauze, sterile cotton for medical purposes, and wound dressings.

A copy of each registration is attached hereto as Exhibits A-D.

8. On information and belief, the Applicant has not used the Shield & Cross Design mark in interstate commerce in connection with the goods identified in application Serial No. 78/295,266 prior to the September 3, 2003 filing date of the application.

9. The goods on which the Opposer uses its marks RED CROSS and Red Cross Design and the goods for which the Applicant seeks to register its Shield & Cross Design mark are both in the fields of personal care products.

10. The goods on which the Opposer uses its marks RED CROSS and Red Cross Design and the goods for which the Applicant seeks to register its Shield & Cross Design mark are highly related.

11. The goods on which the Opposer uses the marks RED CROSS and Red Cross Design and the goods for which the Applicant seeks to register its Shield & Cross Design mark may be sold and/or rendered through the same channels of trade and to the same class of purchasers.

12. The Opposer's marks RED CROSS and Red Cross Design and the Applicant's Shield & Cross Design mark are substantially similar in appearance and commercial impression.

13. Any registration which matures from application Serial No. 78/295,266 creates a legal presumption that Applicant has the right to display the Cross Design portion of the mark in red, in violation of 18 U.S.C. §706.

14. Any registration which matures from application Serial No. 78/295,266 will be read by competitors in the personal products field as enabling Applicant to display the Cross Design depicted therein in any color, including red, in violation of 18 U.S.C. §706.

15. The use and registration by the Applicant of the Shield & Cross Design mark for the goods identified in application Serial No. 78/295,266 is likely to cause confusion, mistake or

deception by having the public erroneously assume or believe that those goods emanate from the Opposer, or are in some other way associated or connected with the Opposer because of the Opposer's prior use and/or registration of the marks RED CROSS and Red Cross Design for medical and first aid supplies, all to the Opposer's irreparable damage.

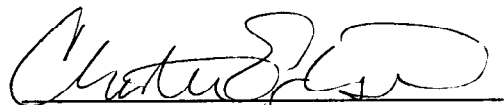
For the reasons set forth in paragraphs 1-15, the Opposer believes and believing asserts that it will be damaged by the registration of application Serial No. 78/295,266. Accordingly, the Opposer prays that this Opposition be sustained, and that the Applicant be refused registration of the Shield & Cross Design mark for the goods set forth in application Serial No. 78/295,266.

This notice is filed in duplicate. Please charge the \$300.00 filing fee to the deposit account of Drinker Biddle & Reath LLP, No. 50-0573.

Respectfully submitted,

JOHNSON & JOHNSON

By:



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Counsel for Opposer.

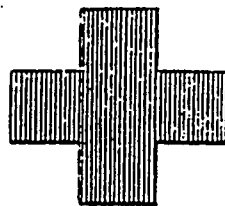
No. 64,308.

TRADE-MARK.

REGISTERED JUNE 26, 1906.

JOHNSON & JOHNSON.
MEDICAL AND SURGICAL PLASTERS.
APPLICATION FILED OCT. 17, 1906.

THIRD RENEWAL



PROPRIETOR

Johnson & Johnson

Attorneys
ATTORNEY

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AFFIDAVIT SEC. 6
ACCEPTED

**RE-RENEWED
RENEWED
REPUBLICISHED**

AFFIDAVIT SEC. 15
RECEIVED 2-9-55

UNITED STATES PATENT OFFICE.

JOHNSON & JOHNSON, OF NEW BRUNSWICK, NEW JERSEY.

TRADE-MARK FOR MEDICAL AND SURGICAL PLASTERS.

No. 54,308

Statement and Declaration.

Registered June 26, 1900.

Application filed October 17, 1905. Serial No. 13,666. Used ten years.

STATEMENT.

In all whom it may concern:

Be it known that the JOHNSON & JOHNSON, a corporation duly organized and existing under and by virtue of the laws of the State of New Jersey, and located and doing business in the city of New Brunswick, county of Middlesex, in said State, has adopted for its use a trade-mark, of which the following is a description.

The trade-mark is illustrated in the accompanying drawing, wherein appears a representation of a red Greek cross.

The trade-mark has been continuously used in the business of said corporation by it and its predecessors, from whom it derived title, since 1887.

The class of merchandise to which the

trade-mark is appropriated is medicinal and surgical articles, and the particular description of goods comprised in said class upon which said trade-mark is used is medicinal and surgical plasters.

The trade-mark is usually displayed on the wrappers, spools, containers, boxes, and other receptacles holding the goods by printing it directly thereon and by means of labels and in other customary ways.

JOHNSON & JOHNSON,
R. W. JOHNSON,

President.

Witnesses:

EDWARD MORRIS,

LOUIS H. LERUESSER.

DECLARATION.

State of New Jersey, county of Middlesex, ss:

R. W. JOHNSON, being duly sworn, deposes and says that he is president of JOHNSON & JOHNSON, a corporation, the applicant named in the foregoing statement; that he believes that the foregoing statement is true; that he believes the said corporation is the owner of the trade-mark sought to be registered; that no other person, firm, corporation or association, to the best of his knowledge and belief, has the right to use said trade-mark either in the identical form or in any such near resemblance thereto as might be calculated to deceive; that said trade-mark is used by said corporation in commerce among the several States of the United States and particularly between New Jersey and Illinois

and between the United States and foreign nations and particularly with Cuba and Canada; and that the description drawing and specimens presented truly represent the trade-mark sought to be registered; and that the mark has been in actual use as a trade-mark of the applicant or its predecessors from whom it derived title for ten years next preceding the passage of the act of February 20, 1905, and that, to the best of his knowledge and belief, such use has been exclusive.

R. W. JOHNSON.

Subscribed and sworn to before me this 14th day of Sept., 1905.

[L. S.]

CHARLES A. McCORDICK,
Notary Public.

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Int. Cls.: 3 and 5

Prior U.S. Cls.: 44 and 51

United States Patent and Trademark Office

Reg. No. 1,870,955

Registered Jan. 3, 1995

**TRADEMARK
PRINCIPAL REGISTER**

RED CROSS

JOHNSON & JOHNSON (NEW JERSEY CORPORATION)
ONE JOHNSON & JOHNSON PLAZA
NEW BRUNSWICK, NJ 08933

FOR: COTTON FOR PERSONAL USE, IN
CLASS 3 (U.S. CLS. 44 AND 51).

FIRST USE 0-0-1898; IN COMMERCE
0-0-1898.

FOR: STERILE COTTON FOR MEDICAL
USE, IN CLASS 5 (U.S. CL. 44).

FIRST USE 0-0-1898; IN COMMERCE
0-0-1898.

OWNER OF U.S. REG. NO. 54,308.

SER. NO. 74-422,554, FILED 8-6-1993.

GERALD C. SEE GARS, EXAMINING ATTOR-
NEY

Int. Cl.: 3

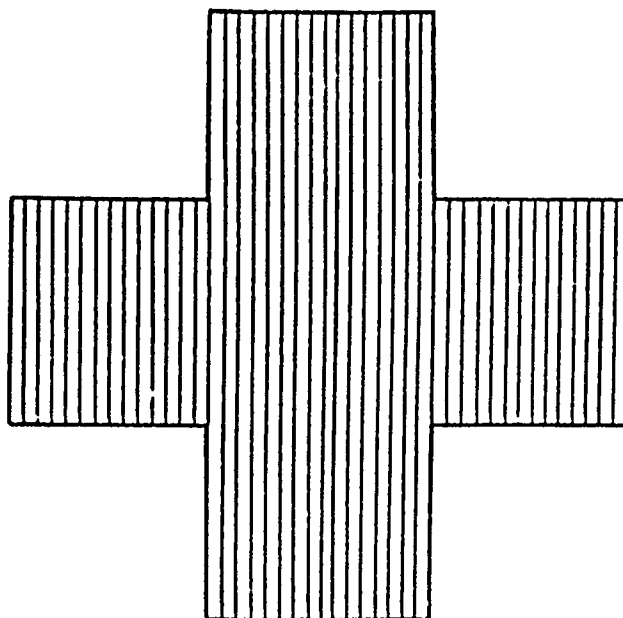
Prior U.S. Cl.: 51

United States Patent and Trademark Office

Reg. No. 1,888,143

Registered Apr. 11, 1995

**TRADEMARK
PRINCIPAL REGISTER**



JOHNSON & JOHNSON (NEW JERSEY CORPORATION)
ONE JOHNSON & JOHNSON PLAZA
NEW BRUNSWICK, NJ 08933

OWNER OF U.S. REG. NO. 54,308.

THE DRAWING IS LINED FOR THE COLOR RED.

FOR: COTTON FOR COSMETIC USE, IN CLASS 3 (U.S. CL. 51).

SER. NO. 74-422,556, FILED 8-6-1993.

FIRST USE 0-0-1898; IN COMMERCE 0-0-1898.

PATRICIA HORRALL, EXAMINING ATTORNEY

Int. Cl.: 5

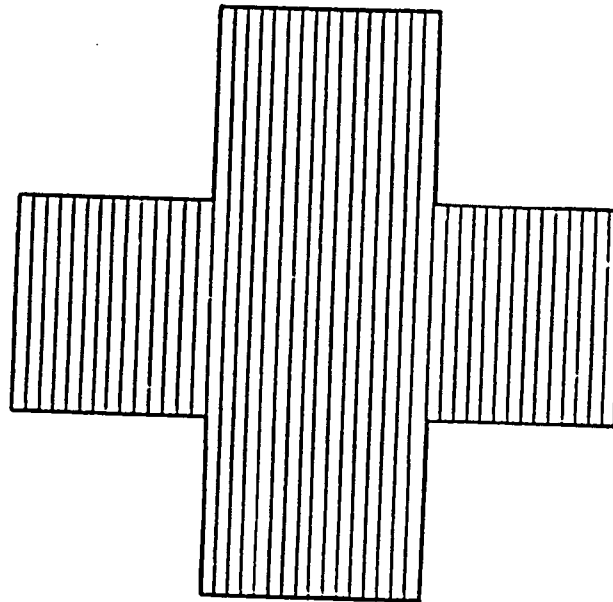
Prior U.S. Cls.: 18 and 44

United States Patent and Trademark Office

Reg. No. 1,889,576

Registered Apr. 18, 1995

**TRADEMARK
PRINCIPAL REGISTER**



JOHNSON & JOHNSON (NEW JERSEY CORPORATION)
ONE JOHNSON & JOHNSON PLAZA
NEW BRUNSWICK, NJ 08933

FOR: FIRST AID KITS, ADHESIVE BANDAGES, TOPICAL PREPARATIONS FOR MEDICAL AND THERAPEUTIC USE, MEDICAL ADHESIVE TAPE, GAUZE, STERILE COTTON FOR MEDICAL PURPOSES, AND WOUND DRESSINGS, IN CLASS 5 (U.S. CLS. 18 AND 44).

FIRST USE 0-0-1898; IN COMMERCE 0-0-1898.

OWNER OF U.S. REG. NO. 54,308.

THE DRAWING IS LINED FOR THE COLOR RED.

SER. NO. 74-422,859, FILED 8-9-1993.

PATRICIA HORRALL, EXAMINING ATTORNEY